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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/024,891 | 12/18/2001 | Steven B. Rogers | 30203/37573 | 5169 |

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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/024,891 | Rogers et al. | |
| | Examiner | Art Unit | |
| | O'Connor | 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 9, 2006 (RCE w/Amdt).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on April 8, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 9, 2006 has been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on June 9, 2006 in reply to the previous Office action on the merits, mailed January 5, 2006.

3. The amendment of claim 1 by applicant in the reply filed June 9, 2006 is hereby acknowledged.

4. The cancellation of claims 31-50 by applicant in the reply filed June 9, 2006 is hereby acknowledged.

5. The "Request for Reassignment of Application to the Appropriate Examining Group" in the reply filed by applicant on June 9, 2006 is hereby acknowledged, and is addressed in the "Response to Arguments" section, hereinbelow.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bugarin et al. (US 6,606,570).

Bugarin et al. disclose a method of configuring a process plant related to analyzing a plurality of process control instruments capable of use in a specific process control environment, comprising: receiving data 415 related to the specific process control environment (see, in particular, Figures 4 and 5), in which at least one of the plurality of process control instruments is potentially to be used, via a computer device; and determining/calculating 420 one or more performance characteristics for each of the plurality of the process control instruments, via the computer device, indicating 425 the performance of each of the process control instruments when used in the specific process control environment (see, in particular, Figures 4 and 6), but Bugarin et al. do not explicitly disclose that the determined/calculated performance characteristics are displayed. However, displaying calculations that a computer has performed is a well known, hence obvious, step to perform for those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Bugarin et al., if

necessary, so as to display the calculations being performed by the computer device (as opposed to merely the results of the calculations--i.e., the list of flow meters deemed suitable for the specified application), in order to allow the customer to evaluate the performance characteristics of the various available meters with respect to the customer's own tolerances and other requirements to determine for themselves which models were suitable, rather than merely accepting/using the default tolerances and requirements of the flow meter manufacturer to determine which models would be acceptable/suitable, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 2, the method of Bugarin et al. includes the step of calculating the performance characteristics for each of the plurality of process control instruments using the received data.

Regarding claim 3, the method of Bugarin et al. includes the step of retrieving, from a memory of the computer device, the performance characteristics for each of the plurality of process control instruments based on the received data.

Regarding claim 4, in the method of Bugarin et al., the computer device is a personal computer.

Regarding claim 5, in the method of Bugarin et al., the computer device is a web-enabled device.

Regarding claim 6, in the method of Bugarin et al., the plurality of process control instruments are each flow meters.

Regarding claim 7, in the method of Bugarin et al., at least one of the plurality of process control instruments is a Coriolis type of flow meter.

Regarding claims 8-12, in the method of Bugarin et al., each of the process control instruments is a Coriolis type of flow meter, not a vortex, magnetic, differential pressure, thermal mass, or ultrasonic type of flow meter. However, each of these types of meters is well known, hence, obvious type of flow meter to purchase, to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Bugarin et al. so as to sell various types of flow meters, including any of vortex, magnetic, differential pressure, thermal mass, or ultrasonic types of flow meters, instead of selling only Coriolis types of flow meters, in order to increase sales by offering a greater selection of products, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 13, in the method of Bugarin et al., the receiving step is performed by entering the data through a keyboard of the computer device.

Regarding claim 14, in the method of Bugarin et al., the receiving step is performed by downloading the data from a memory.

Regarding claim 15, in the method of Bugarin et al., the receiving step is performed by importing the data from a database.

Regarding claims 16-19 and 28, Bugarin et al. do not specifically disclose that the calculating step involves the step of calculating performance characteristics of each of the

plurality of process control instruments over an entire range of operation of each process control instrument (“entire range” being construed as equivalent to “from a minimum to a maximum”). However, calculating performance characteristics over an entire range of operation, as opposed to merely a single point, displaying that range of results graphically, and providing comparisons between installed conditions and reference conditions, are all well known to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Bugarin et al. so as to calculate performance characteristics over an entire range of operation, as opposed to merely a single point, display that range of results graphically, and provide comparisons between installed conditions and reference conditions, as is all well known to do, in order to ensure that the flow meter would operate properly in its intended application, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 20, in the method of Bugarin et al., the calculating step further includes the step of calculating the size of the process control instrument needed to satisfy the process control application.

Regarding claim 21, the method of Bugarin et al. includes the step of saving the received data in a memory of the computer device.

Regarding claim 22, the method of Bugarin et al. includes the step of assigning an electronic tag to the saved data to facilitate later retrieval.

Regarding claim 23, in the method of Bugarin et al., the receiving data step includes receiving a selection of the plurality of process control instruments to be used in the analysis.

Regarding claims 24 and 26, in the method of Bugarin et al., the process control instruments are each flow meters, and the calculating step includes both: the step of calculating flow meter accuracy as a continuous function of flow rate; and, the step of calculating fluid pressure losses for each of the flow meters.

Regarding claims 25, 27, 29, and 30, the recited functionality is not specifically disclosed by Bugarin et al. However, manually/conventionally performing the recited steps of calculating straight pipe requirements for each of the flow meters; calculating pressure loss due to pipe fittings; calculating installed costs associated with the plurality of process control instruments; and, depicting the pipe, pipe fittings, and flow meters graphically (as in an engineering drawing/layout/blueprint), are all well known, hence obvious, to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Bugarin et al. so as to adapt the computer device to perform the recited calculations and depictions that are otherwise well known to perform manually, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, and since it has been held that simply providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Response to Arguments

8. Applicant's arguments filed June 9, 2006 have been fully considered but they are not deemed persuasive.

9. Regarding the argument that the application should be reassigned to the appropriate examining group, the application is already assigned to the appropriate examining group. Note that whether or not the words "business" and "method" appear together in the claims is irrelevant to whether or not the claims are properly considered drawn to a "business method" invention.

10. Regarding the argument that Bugarin et al. simply fail to provide any disclosure or suggestion of "determining performance characteristics of various process control instruments based on a specific use or manner of use of those process control instruments within a specific process control environment," Bugarin et al. indeed explicitly disclose "determining performance characteristics of various process control instruments based on a specific use or manner of use of those process control instruments within a specific process control environment. See, in particular, Figure 4, especially steps 415, 420, and 425, as well as all of Figures 5 (receiving/specifying the specific process control environment in which the process control instruments are to be analyzed to determine their performance characteristics) and Figure 6 (determining/calculating the performance characteristics for the process control instruments to potentially be used in the specific/defined process control environment).

11. Regarding the argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., enabling a user to determine which process control instrument is "*best suited*" to the particular use within the specific process control environment being modeled/analyzed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. Regarding the arguments against the references (official notice) individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

13. Regarding the argument that there is no suggestion to modify or combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge generally available to one of ordinary skill in the art would include all of the stated motivations to modify or combine.

14. Regarding the argument that the examiner has failed to provide a reference as evidence of what the examiner has found to be “well known” prior art, such arguments are no longer considered seasonable, since the objects of the well known statements have previously been indicated as having been deemed admitted prior art. See MPEP § 2144.03(C).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to the disclosure.

16. All rejected claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

17. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

July 18, 2006

7/18/06

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627